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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,383	08/01/2001	Shunsuke Yajima	70904-56304	4400
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EDWARDS & ANGELL, LLP			JOO, JOSHUA	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			2154	

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/920,383	Applicant(s) YAJIMA ET AL.	
	Examiner Joshua Joo	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10, 12, 14, 16, 18, 20, 22, 24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10, 12, 14, 16, 18, 20, 22, 24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/1/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/26/06</u> | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment filed 4/14/2006

1. Claims 1-6, 8, 10, 12, 14, 16, 18, 20, 22, 24, and 26 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/14/2006 has been entered.

Drawings

3. Drawings filed 8/01/2001 are accepted by the Examiner.

Response to Arguments

4. Applicant's arguments with respect to claims 1-6, 8, 10, 12, 14, 16, 18, 20, 22, 24, and 26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-6, 8, 10, 12, 14, 16, 18, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte, US Patent #6,862,583 (Mazzagatte hereinafter), in view of Francis et al, US Patent #6,650,430 (Francis hereinafter) and Reilly, US Publication #2003/0126328 (Reilly hereinafter).

7. As per claim 1, Mazzagatte teaches substantially the invention as claimed including the method and system for generating print data and identification data, where printing is based on matching of identification information, Mazzagatte's teachings comprising:

data preparation means for preparing operation data and identification data corresponding to the operation data (Col 7, lines 46-48; Col 8, lines 19-23. Submits print data and identification information.);

an electronic device which carries out processing based on the operation data prepared by said data preparation means (Col 9, lines 61-62. Printer prints data.); and

said portable data storage means including identification data storage means for storing the identification data (Col 8, lines 35-38. Smart card contains identification information. Col 5, lines 23-25. Write to smart card.),

wherein said portable data storage means transmits automatically the identification data stored in said identification data storage means to said electronic device when said portable data storage means approaches said electronic device (Col 9, lines 56-59. Upon presenting the smart-card to the printer, printer first verifies the unique identification information.), and when said electronic device receives the identification data from said portable data storage means (Col 9, lines 56-59. Printer verifies information smart card.), said electronic device carries out the processing based on the operation data corresponding to the identification data (Col 9, lines 61-62. Printer proceeds with printout process.).

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8. Mazzagatte teaches substantial features of the claimed invention including using identification data corresponding to the print job (Claim 1; Col 8, lines 19-23); a smart-card interface device to write to the smart card (Col 5, lines 23-25); and linking identification information on the smart card with the print job (Col 9, lines 57-58). However, Mazzagatte does not teach of receiving identification data from a data preparation device; and identification data that uniquely identifies the operation data.

9. Francis teaches of entering information into the memory of a smart card (Col 3, lines 40-52) and transmitting the information to the printer (Col 7, lines 37-40).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Francis because both teachings deal with providing secure printing by using smart cards that contain identification information. Furthermore, the teachings of Francis to enter the identification information into the smart card would improve the teachings of Mazzagatte by specifying how the smart card contains the identification information and allowing the smart card to be updated with newer information.

11. Reilly teaches of producing a unique ID for a print job (Paragraph 0022).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Francis, and Reilly because since Mazzagatte teaches the concept of using identification information to correspond to a print job, it would have been obvious to use a unique ID identifying the print job as well. Therefore, the teachings of Reilly would improve the system of Mazzagatte and Francis by using the unique ID to reference print jobs and acquire additional information and status of the print job (Paragraph 0022).

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13. As per claim 22, Mazzagatte teaches substantially the invention as claimed including a portable data storage device for storing identification data and using the identification to print data, Mazzagatte's teachings comprising:

a data preparation device (Col 7, lines 46-47. Computer) which prepares operation data to control the operation of an electronic device and identification data corresponding to the operation data (Col 8, lines 19-24. Submits print job with identification information.),

storage means for storing the identification data (Col 8, lines 34-37. Smart card contains identification information.); and

a transmitting section automatically transmitting the identification data stored in said storage means to said electronic device when said portable data storage means approaches said electronic device (Col 9, lines 56-59. Upon presenting the smart-card to the printer, printer first verifies the unique identification information.) which carries out the processing based on the operation data corresponding to the received identification data (Col 9, lines 61-62; Col 10, lines 16-19. Printout process.).

14. Mazzagatte teaches substantial features of the claimed invention including identification data corresponding to the print job (Claim 1; Col 8, lines 19-23; being able to write on to the smart card (Col 5, lines 23-25); and linking identification information with the print job (Col 9, lines 57-58). However, Mazzagatte does not explicitly teach of a receiving section for receiving identification data from a data preparation device; and identification data that uniquely identifies the operation data.

15. Francis teaches of entering information into the memory of a smart card (Col 3, lines 40-52) and transmitting the information to the printer (Col 7, lines 37-40).

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16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Francis because the teachings of Francis to enter information into the smart card and for the smart card to transmit the information from the smart card would improve the teachings of Mazzagatte by specifying how the smart card contains the identification information and allowing for the updating of information in the smart card.

17. Reilly teaches of producing a unique ID for a print job (Paragraph 0022).

18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Francis, and Reilly because since Mazzagatte teaches the concept of using identification information to correspond to a print job, it would have been obvious to use a unique ID identifying the print job as well. Therefore, the teachings of Reilly would improve the system of Mazzagatte and Francis by using the unique ID to reference print jobs and acquire additional information and status of the print job (Paragraph 0022).

19. As per claim 24, Mazzagatte teaches substantially the invention as claimed including the method and apparatus for generating print data and identification data, where printing is based on matching of identification information, Mazzagatte's teachings comprising:

a data preparation section for preparing operation data to control the operation of an electronic device and identification data corresponding to the operation data (Col 8, lines 20-24.

User submits print job and identification information. Col 7, lines 45-47. Computer.);

an operation data transmitting section for transmitting the operation data prepared by said data preparation section to said electronic device (Col 8, lines 59-61. Transmits print job to the printer.);

a portable data storage device which stores the received identification data and automatically transmits the stored identification data to said electronic device when said portable data storage means approaches said electronic device (Col 9, lines 56-59. Upon presenting the smart-card to the printer, printer first verifies the unique identification information.),

wherein said electronic device, upon receipt of the identification data from said portable data storage device, performs an operation based on the operation data corresponding to the received identification data, selected from among a plurality of operation data received from said operation data transmitting section (Col 10, lines 12-20. Print jobs. Compares received identification information with identification information stored with a print job. Col 10, lines 38-40. Printers data.).

20. Mazzagatte teaches substantial features of the claimed invention including identification data corresponding to the print job (Claim 1; Col 8, lines 19-23; being able to write on to the smart card (Col 5, lines 23-25); and being able to write on to the smart card (Col 5, lines 23-25) and linking identification information with the print job (Col 9, lines 57-58). However, Mazzagatte does not explicitly teach of a receiving section for receiving identification data from a data preparation device; and identification data that uniquely identifies the operation data..

21. Francis teaches of providing secure printing, where the computer enters identification information into the memory of the smart card (Col 3, lines 50-52). The smart card transmits information from the smart card to the printer (Col 7, lines 36-39), where the smart card can be a contactless smart card or a RF identification card (Col 3, lines 59-64). .

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Francis because both teachings deal with

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providing secure printing by using smart cards that contain identification information.

Furthermore, the teachings of Francis to input information to the smart card and to transmit information to the printer would improve the teachings of Mazzagatte by specifying how the smart card contains the identification information and allows for the updating of the smart card.

23. Reilly teaches of producing a unique ID for a print job (Paragraph 0022).

24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Francis, and Reilly because since Mazzagatte teaches the concept of using identification information to correspond to a print job, it would have been obvious to use a unique ID identifying the print job as well. Therefore, the teachings of Reilly would improve the system of Mazzagatte and Francis by using the unique ID to reference print jobs and acquire additional information and status of the print job (Paragraph 0022).

25. As per claim 2, Mazzagatte teaches the electronic device control system of claim 1, further comprising: transmitting means for transmitting the operation data prepared by said data preparation means to said electronic device (Col 8, lines 59-63. Sender submits print job and is transmitted to the printer.).

26. As per claim 3, Mazzagatte teaches the electronic device control system of claim 2 wherein: said transmitting means is a network, which connects at least one data preparation means and at least one electronic device (Fig 1. #100).

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27. As per claim 4, Mazzagatte does not teach the electronic device control system of claim 1, wherein: said portable data storage means receives the identification data from said data preparation means and transmits the identification data to said electronic device by wireless.

28. Francis teaches of inputting identification information into the memory of a smart card, wherein the smart card can be a contactless smart card or a RF identification card (Col 3, lines 59-64). Francis also teaches of transmitting information from the smart card to the printer (Col 7, lines 18-20, 36-39).

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Francis, and Reilly because the teachings of Francis to provide a contactless card and to transmit information to the printer would improve the system of Mazzagatte, Francis, and Reilly by printing without having the smart card come in contact with the printer, and for the printer to receive the information to verify the identification information.

30. As per claim 5, Mazzagatte teaches the electronic device control system of claim 1, wherein:

said electronic device includes operation data storage means for storing the operation data transmitted from said data preparation means (Col 9, lines 8-10. Printer stores print data.); and

said electronic device checks the operation data stored in said operation data storage means against the identification data received from said portable data storage means when receiving the identification data (Col 9, line 56-58. Printer verifies the identification information from smart card.), detects the operation data corresponding to the received identification data

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(Col 10, lines 14-18. Compares information from smart card with identification stored in print queue.), and carries out the processing based on the operation data (Col 10, line 20. Printout process.).

31. As per claim 6, Mazzagatte teaches the electronic device control system of claim 3 further comprising: operation data management means (Col 6, line 62. Server), connected to said network, for storing the operation data prepared by said data preparation means and for managing a data output process to output the operation data to said electronic device (Col 6, lines 62-65. Server queues print data and sends data to a printer.).

32. As per claim 8, Mazzagatte teaches the electronic device control system of claim 1, wherein:

said electronic device includes display means (Col 9, line 65. Display on printer.); and
said electronic device includes control means which confirms the content of the operation data (Col 20-24. Notifies of print job in queue.), judges whether or not said electronic device has function means for performing a selected function required to perform an operation based on the operation data (Col 9, lines 57-59; Col 10, lines 17-19. Verifies print data to print or not.), then indicates the judgment result on said display means (Col 9, lines 65-66. Displays notification.).

33. As per claim 10, Mazzagatte teaches the electronic device control system of claim 1, wherein:

said portable data storage means also stores user management identification data (Col 8, lines 20-37. Smart card contains identification information such as name, organization, and

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other information.), and transmits user management identification data on said electronic device (Col 9, lines 53-58. Printer reads and verifies the identification information.); and

said electronic device controls to limit the performance of an operation of said electronic device based on the user management identification data received from said portable data storage means (Col 9, lines 60-64. If identification information is verified, printer proceeds with printout process. If not, notification is made of failure.).

34. As per claim 12, Mazzagatte teaches the electronic device control system of claim 10, wherein:

the user management identification data includes data of at least one kind selected from the group consisting of department identification data identifying the department in which said data preparation means for preparing operation data is installed (Col 8, lines 27-30. Identification information includes organization unit.), user identification data set for each user (Col 8, lines 27-30. User's information.), and storage means identification data for each portable storage means (Col 8, lines 34-38. Smart card contains identification information.).

35. As per claim 14, Mazzagatte teaches the electronic device control system of claim 10 wherein: the user management identification data is registered in said portable data storage means in advance (Col 8, lines 25-30, 33-37. Smart card contains identification information including user information data.).

36. As per claim 16, Mazzagatte teaches the electronic device control system of claim 1, wherein: said electronic device is an image output device (Col 9, lines 57-58. Printer.), and the operation data is print data (Col 9, lines 9. Print data.).

37. As per claim 18, Mazzagatte teaches the electronic device control system of claim 1, wherein: said data preparation means is a personal computer (Col 7, lines 46-47. Desktop computer.).

38. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte, Francis, and Reilly, in view of Peters, US Patent #6,601,093 (Peters hereinafter).

39. As per claim 20, Mazzagatte teaches that the portable data storage may be a smart card (Col 8, lines 33-34). However, Mazzagatte does not teach the electronic device control system of claim 1, wherein: said portable data storage means includes at least one element selected from the group consisting of a portable phone; and a portable information processing terminal.

40. Peters teaches the concept of a wireless device transmitting information to a printer (Col 4, lines 36-50).

41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Francis, Reilly, and Peters because the teachings of Peters for a wireless device to transmit information to a printer would improve the system of Mazzagatte, Francis, and Reilly by providing different mobile devices that can store identification information and be implemented in the system.

42. Claim 26 is rejected under 35 U.S.C. 102(e) as being unpatentable by Mazzagatte, in view of Reilly.

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43. As per claim 26, Mazzagatte teaches substantially the invention as claimed including an apparatus for receiving print data and identification data, where printing is based on matching of identification information, Mazzagatte's teachings comprising:

an operation data receiving section for receiving operation data from a data preparation device (Col 8, lines 59-63. Computer transmits print data to printer.) which prepares the operation data and identification data corresponding to the operation data (Col 9, lines 8-10. Print data and identification information.);

an identification data receiving section for receiving the identification data transmitted automatically from a portable storage device when the portable data storage means approaches said electronic device (Col 9, lines 56-59. Upon presenting the smart-card to the printer, printer first verifies the unique identification information.), the identification data receiving section having a function to store the identification data received from said data preparation device (Col 8, lines 35-37. Smart card contains identification information. Col 9, lines 52-55. Verifies identification information from smart card. Col 10, lines 16-19. Identification data stored in print queue.); and

an operation section for performing an operation based on the operation data which is received by said operation receiving section and corresponds to the identification data received by said identification data receiving section (Col 10, lines 16-19. Compares identification information from smart card with identification information with print data.).

44. Mazzagatte teaches substantial features of the claimed invention including identification data corresponding to the print job. However, Mazzagatte does not teach of identification data that uniquely identifies the operation data.

45. Reilly teaches of producing a unique ID for a print job (Paragraph 0022).

46. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Francis, and Reilly because since Mazzagatte teaches the concept of using identification information to correspond to a print job, it would have been obvious to use a unique ID to identifying the print job as well. Therefore, the teachings of Reilly would improve the system of Mazzagatte and Francis by using the unique ID to reference print jobs and acquire additional information and status of the print job (Paragraph 0022).

Conclusion

47. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on 571 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 30, 2006
JJ

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